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24038	7590	01/13/2004	EXAMINER	
MARTIN & ASSOCIATES, LLC P O BOX 548 CARTHAGE, MO 64836-0548			GELIN, JEAN ALLAND	
		ART UNIT	PAPER NUMBER	
		2681	8	
DATE MAILED: 01/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/591,331	BATES ET AL.	
Examiner	Jean A Gelin	Art Unit	2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 30 October 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-8,11,13-24, 27,28 and 30-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8,11,13-24,27,28 and 30-33 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ . 6)  Other: \_\_\_\_ .

## DETAILED ACTION

1. This is in response to the Applicant's amendments and arguments October 30, 2003 in which claims 1, 17, 28, and 30 have been amended, claims 9, 10, 12, 25, 26, and 29 have been canceled. Claims 1-8, 11, 13-24, 27, 28, and 30-33 are currently pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 11 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Lauper (US Patent Application Publication Number 2002/0086659).

As to claim 11, Lauper discloses, in Figure 1, a portable phone (10) comprising: a position detector that detects geographical position of the portable phone (e.g., GPS receiver); and a dial mechanism (100) coupled to the position detector for selecting stored text that corresponds to a desired telephone contact (see portion of paragraph 18 appearing on page 2), such that when a user selects the stored text, the dial mechanism dials a first stored telephone number when the portable phone is in a first defined region and dials a second stored telephone number when the portable phone is in a second defined region (see paragraph 30, wherein telephone numbers of mobile

users 12 and 13 are inherently stored at some point in the procedure, and wherein their numbers will change depending on the detected location). Also, Lauper discloses that the dial mechanism dials a first stored telephone number and communicates the detected geographical position of the portable phone with the call to the first stored telephone number (see paragraph 30 -"The user's position can ...be communicated to the system 21 as part of the emergency call message").

As to claim 28, Lauper discloses a method for making a call on a portable phone (10 in Fig. 1), the method comprising the steps of:providing a position detector (e.g., GPS receiver) with the portable phone that detects geographical position of the portable phone; detecting the geographical position of the portable phone using the position detector (see paragraph 30 - "The user's position can however also be determined by the mobile device 10, for example with a GPS receiver..."); selecting stored text (100) that corresponds to a desired telephone contact (see portion of paragraph 18 appearing on page 2); dialing a first stored telephone number corresponding to the desired telephone contact when the portable phone is in a first defined region; and dialing a second stored telephone number corresponding to the desired telephone contact when the portable phone is in a second defined region (see paragraph 30, wherein telephone numbers of mobile users 12 and 13 are inherently stored at some point in the procedure, and wherein their numbers will change depending on the detected location).

Also, Lauper discloses the steps of dialing a first stored telephone number and communicating the detected geographical position of the portable phone with the call to

the first stored telephone number (see paragraph 30 -"The user's position can ...be communicated to the system 21 as part of the emergency call message").

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2, 6, 17-18, 22, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lauper in view of Kuwahara et al. (US 6,389,288).

As to claims 1, 2, 17, 18, Lauper teaches a portable phone comprising: a position detector that detects geographical position of the portable phone (e.g., GPS receiver, paragraph 30); and a processor coupled to the position detector that determines the position of the portable phone based on the detected geographical position when a call is received by the portable phone (i.e., inherently a processor is coupled to the GPS to determine mobile position, paragraph 30); and a dial mechanism (100) coupled to the position detector for selecting stored text that corresponds to a desired telephone contact (see portion of paragraph 18 appearing on page 2), such that when a user selects the stored text, the dial mechanism dials a first stored telephone number when the portable phone is in a first defined region and dials a second stored telephone number when the portable phone is in a second defined region (see paragraph 30, wherein telephone numbers of mobile users 12 and 13 are inherently stored at some

point in the procedure, and wherein their numbers will change depending on the detected location). Also, Lauper discloses that the dial mechanism dials a first stored telephone number and communicates the detected geographical position of the portable phone with the call to the first stored telephone number (see paragraph 30 -"The user's position can ...be communicated to the system 21 as part of the emergency call message").

Lauper does not specifically teach a processor coupled to the position detector that determines whether or not to ring the portable phone based on the position of the portable phone when receiving a call.

However, the preceding limitation is known in the art of communications. Kuwahara teaches automatically using the ringing tone depending on the location of the mobile user (col. 5, lines 1-5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the technique of Kuwahara within the system of Lauper in order for the mobile communication terminal to automatically select a ringing tone or vibrator when receiving a call based on the location of the user communication terminal without user intervention to manually select a desired mode to alert an incoming call.

As to claims 6, 22, the combination system of Lauper and Kuwahara discloses everything as applied to claim 1 above. In addition, Kuwahara discloses that the processor does not ring the portable phone if the portable phone is in a predefined region (see Figure 13 entries for zones C5 and B 10, for example).

As to claims 30-31, Lauper discloses a method for receiving a call on a portable phone (paragraph 11), the method comprising the steps of: providing a position detector with the portable phone that detects geographical position of the portable phone (paragraph 30); detecting the geographical position of the portable phone using the position detector (i.e., using GPS, paragraph 30); assigning a telephone number to a defined geographical region (i.e., call message is distributed on basis of the position of the mobile, paragraph 30); dialing the telephone number assigned to the defined geographical region (i.e., for sending call message to terminal having the highest level corresponding to terminal positioned closer to the portable phone, paragraph 34).

Lauper does not disclose the portable phone causing itself to ring if the detected geographical position of the portable phone is within the defined geographical region.

However, the preceding limitation is known in the art of communications. Kuwahara teaches user can set the mobile communication terminal to a ringing tone or vibrate based on the location of the user communication terminal (col. 5, lines 1-5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the technique of Kuwahara within the system of Lauper in order for the mobile communication terminal to automatically ring when receiving a call based on the location of the user communication terminal.

Regarding claim 31, Lauper in view of Kawahara teaches all the limitations. Lauper further teaches wherein the position detector comprises a global positioning system (GPS) detector (paragraph 31).

Regarding claim 32-33, Lauper in view of Kawahara teaches all the limitations. In comparison to the step of not ringing the portable phone, but instead delivering a voice message, and when the assigned telephone number of the defined region is called and the portable phone is outside the defined geographical region, Kawahara further teaches when the mobile user is not in common area to receive ringing tone, col. 1, lines 20-27, lines 63-67, setting of the mobile communication terminal is automatically changed based on the reported location information, col. 2, lines 54-58, which can perform the function of the claimed invention.

6. Claims 3-5, 7-8, 19-21, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination system of Lauper and Kuwahara as applied to claims 1 and 17 above, and further in view of Finke-Anlauff (USPN 5479476).

As to claims 3-4, 7-8, Lauper and Kuwahara fails to explicitly recite that the processor further determines characteristics of a ring signal. Kuwahara also fails to explicitly recite that the processor rings the portable phone with increased volume or a different ring tone if the portable phone is in a predefined region.

In an analogous art, Finke-Anlauff discloses a portable phone comprising a processor (32 in Fig. 2) that determines whether or not to ring the portable phone based on the geographical position of the portable phone when a call is received by the portable phone (see col. 4 lines 5058). Finke-Anlauff also discloses, in Figure 3, that the processor further determines characteristics of a ring signal based on the geographical position of the portable phone when the processor determines to ring the portable phone, wherein the characteristics of the ring signal include volume, type, and tone of

the ring signal, and wherein the processor rings the portable phone with increased volume (e.g., see row labeled sound volume) or with a different ring tone (e.g., see row labeled ringing tone) if the portable phone is in a predefined region (see Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination system of Lauper and Kuwahara to include the determination of ring signal characteristics, as taught by Finke-Anlauff, for the purpose of providing the user with a wide range of adjustments that can quickly be changed (see col. 2 lines 1-5).

As to claim 5, the combination system of Lauper, Kuwahara, and Finke-Anlauff disclose everything as applied to claim 4 above. In addition, Kuwahara discloses that the type of the ring signal includes an audible ring and a vibration ring (see Figure 13).

As to claims 19-20, 23-24, Lauper in view of Kuwahara fails to explicitly recite the step of determining characteristics of a ring signal. Kuwahara also fails to explicitly recite that step (C) rings the portable phone with increased volume or a different ring tone if the portable phone is in a predefined region.

In an analogous art, Finke-Anlauff discloses a method comprising the step of determining whether or not to ring a portable phone based on the geographical position of the portable phone when a call is received by the portable phone (see col. 4 lines 50-58). Finke-Anlauff also discloses, in Figure 3, the step of determining characteristics of a ring signal based on the geographical position of the portable phone, wherein the characteristics of the ring signal include volume, type, and tone of the ring signal and wherein the portable phone rings with increased volume (e.g., see row labeled sound

volume) or with a different ring tone (e.g., see row labeled ringing tone) if the portable phone is in a predefined region (see Figure 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination system of Lauper and Kuwahara to include the step of determining ring signal characteristics, as taught by Finke-Anlauff, for the purpose of providing the user with a wide range of adjustments that can quickly be changed (see col. 2 lines 1-5).

As to claim 21, the combination system of Lauper, Kuwahara, and Finke-Anlauff disclose everything as applied to claim 20 above. In addition, Kuwahara discloses that the type of the ring signal includes an audible ring and a vibration ring (see Figure 13).

7. Claims 13-16 are rejected under 35 U. S. C. 102(e) as being anticipated by Bijanki et al (USPN 6539223) ("Bijanki").

As to claims 13-14, Bijanki discloses a telephone system comprising: a portable phone (108 in Fig. 2) that includes a position detector that detects geographical position of the portable phone (see col. 2 lines 10-13); wherein the position detector comprises a global positioning system (GPS) detector (see col. 2 lines 12-13); a defined geographical region that is assigned a telephone number (see col. 1 line 60 through col. 2 line 3); a processor coupled to the portable phone that determines from the position detector the geographical position of a portable phone, and that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region (see col. 5 lines 6-15).

As to claims 15-16, Bijanki discloses everything as applied to claim 13 above. In addition, Bijanki discloses that the processor does not ring the portable phone, but instead delivers a voice message (e.g., the subscriber's answering service - see col. 5 lines 20-21, or also the alerting message - see col. 5 lines 27-32), when the assigned telephone number of the defined region is called and the portable phone is outside the defined geographical region (see col. 5 lines 15-32).

8. Claims 13-15, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich(a) (USPN 5924041) in view of Alperovicli(b) (USPN 6233448).

As to claims 13-14, Alperovich(a) discloses a telephone system comprising: a network (145) that includes a position detector that receives geographical position of the portable phone (see col. 5 lines 35-50 ); a defined geographical region (e.g.. location area) that is assigned a telephone number (see col. 6 lines 48-50 - "...a telephone number can be associated with a given geographical location..."); a processor (in network 145) coupled to the network that determines from the position detector the geographical position of a portable phone, and that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region (see col. 6 line 43 through col. 7 line 2).

However, Alperovich(a) fails to explicitly recite that the position detector is in the portable phone and coupled to the processor.

In an analogous art, Alperovich(b) discloses a portable phone that includes a position detector that detects geographical position of the portable phone and comprises a global positioning system (GPS) detector (see col. 3 lines 29-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alperovich(a) with a position detector in the portable phone, as taught by Alperovich(b), for the purposes of increasing the resolution and accuracy of the position detector to "within about  $\pm$  10 feet."

As to claim 15, the combination of Alperovich(a) and Alperovich(b) disclose everything as applied to claim 13 above. In addition Alperovich(a) discloses that the processor does not ring the portable phone when the assigned telephone number of the defined region is called and the portable phone is outside the defined geographical region (see col. 6 lines 52-65).

As to claims 30-31, Alperovich(a) discloses a method for making a call or a portable phone, the method comprising the steps of: providing a position detector with a network (145) that detects geographical position of the portable phone; detecting the geographical position of the portable phone using the position detector (see col. 5 lines 35-50); assigning a telephone number to a defined geographical region (e.g., location area) (see col. 6 lines 48-50 - "...a telephone number can be associated with a given geographical location..."); ringing the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region (see col. 6 line 43 through col. 7 line 2).

However, Alperovich(a) fails to explicitly recite that the position detector is located with the portable phone.

In an analogous art, Alperovich(b) discloses a portable phone that includes a position detector that detects geographical position of the portable phone and comprises a global positioning system (GPS) detector (see col. 3 lines 29-34). It would have been obvious to one: of ordinary skill in the art at the time the invention was made to modify Alperovich(a) with a position detector in the portable phone, as taught by Alperovich(b), for the purposes of increasing the resolution and accuracy of the position detector to "within about  $\pm 10$  feet."

As to claim 32, the combination of Alperovich(a) and Alperovich(b) disclose everything as applied to claim 30 above. In addition Alperovich(a) discloses the step of not ringing the portable phone when the assigned telephone number of the defined region is called and the portable phone is outside the defined geographical region (see col. 6 lines 52-65). 9

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination system of Kuwahara and Alperovich as applied to claim 17 above, and further in view of Fitch et al (USPN 6424840).

Kuwahara and Alperovich fail to explicitly recite the step of routing a call using the communicated geographical position of the portable phone to a second telephone that is the closest of a predefined group of telephones in physical proximity to the portable phone.

In an analogous art, Fitch et al discloses the step of routing a received call using the communicated geographical position of the portable phone to a second telephone

that is the closest of a predefined group of telephones in physical proximity to the portable phone (see col. 6 lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination system of Kuwahara and Alperovich to include the step of routing a received call to the closest of a predefined group of telephones in physical proximity to the portable phone, as taught by Fitch. One of ordinary skill in the art would have been motivated to make this modification because it would help expedite the service desired (such as pizza delivery, car towing, and such - see col. 6 lines 48-50 of Fitch).

***Response to Arguments***

10. Applicant's arguments filed October 30, 2003 have been fully considered but they are not persuasive.

The Applicant argues that Lauper does not teach the dial mechanism recited in claims 11 and 28. The Applicant argues that, in Lauper a fixed device receive the call and decide where to route the call; the mobile terminal itself does not decide which mobile unit 12 and 13 to call. The mobile does not directly dial different telephones. However, the Applicant disagrees with the preceding arguments. The Examiner would like to draw applicant's attention to the fact that Lauper is very pertinent to the Applicant's invention namely the emergency call message is distributed on the basis of the position indication determined by the mobile device. An emergency call address list is stored in the memory of the mobile device and the mobile user can organize terminals in the list hierachically. The list can be updated according to the current location of the

mobile user. Predefined mobiles are stored in the mobile device; as the mobile user is moving, the mobile device is connected to other mobile devices in the new vicinity.

According to the Applicant, nowhere does Lauper teach or suggest that the mobile unit can call two different stored telephone numbers depending on the geographic location of the mobile unit. However, the mobile device having a memory stores predefined mobiles, and communicates to the predefined mobile when the mobile user is in the vicinity of the predefined mobile. Clearly, the claimed invention is read on the system of Lauper and the rejection is maintained.

The Applicant argues with respect to claims 13-16 and 30-33 that Bijanki does not disclose a defined geographic region that is assigned a telephone number. The Applicant further argues the directory number of Bijanki is not a telephone number. However, the Examiner disagrees with the preceding argument. According to Newton dictionary, a directory number is a phone number. Therefore, the Examiner considers the directory number taught by Bijanki as phone number to complete calls. The rejection is maintained.

As per claims 13-15, in page 15 of the Remarks, the Applicant further argues that claim 13 has been amended to specify that the processor is in the portable phone, and the functions cited in the prior art as allegedly reading on the processor are performed by the phone system not by the phone itself. It appears that the Applicant overlooks the teaching of the use of GPS within a mobile station to determine the position of the mobile taught by Alperovich (448) teaches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alperovich(a) with a

position detector in the portable phone, as taught by Alperovich(b), for the purposes of increasing the resolution and accuracy of the position detector to "within about  $\pm 10$  feet." (see rejection above).

The Applicant argument for the rejection of claim 30 is similar to the argument of claim 13 above. Therefore, the Examiner argument for claim 30 is also similar to the argument of claim 13 above.

The Applicant further argues that claims 14-16 depend on allowable claim 13 for the reasons given above. The Examiner does not concur the preceding assertion. Therefore, the claims are rejected for the reason given in the previous Office Action.

New ground of rejection is applied for claims 30-33 are in view of the Applicant's amendment.

The Applicant further argues that claims 1, 2, 6, 17, 18, and 22 need not be addressed because claim 1 is amended to include the limitation of claim 9. The rejection of claim 9 is addressed in page 13. The Applicant repeats the argument of claims 11 and 28 discussed above for claim 9. Therefore, the Examiner repeats the same argument for the rejection of the added portion of claims 1 and 17 as the amended claims are rejected in the Office Action above, accordingly.

The Applicant further argues that claims 2-8 and 18-24 are allowable because they depend on claims 1 and 17. However, claims 1 and 17 are rejected for the reason recited above. Therefore, the rejection of claims 2-8 and 18-24 is maintained (see the rejection above).

The Applicant states that claims 9, 10, 25, and 26 have been canceled. The Examiner acknowledges the cancellation of claims 9, 10, 25, and 26.

The Examiner argues that claim 27 is allowable because it depends on claim 17. the rejection of claim 17 is maintained. Therefore, claim 27 is rejected for the same reason above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A Gelin whose telephone number is (703) 305-4847. The examiner can normally be reached on 9:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703) 305-4040. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4847.

**JEAN GELIN  
PATENT EXAMINER**

JGelin  
January 12, 2004

*jean Alland Gelin*